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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,206	01/09/2001	R. Mark Halligan	77901	1306

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,206	Applicant(s) HALLIGAN ET AL	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005 and 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 and 119-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 and 119-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is in response to the applicant's communication filed on January 18, 2005 and June 14, 2005, wherein:

Claims 1-70 and 119-121 are currently pending;

Claims 71-95 have been withdrawn from consideration due to a restriction requirement;

Claims 1-70 have been modified;

Claims 119-121 have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 18, 2005 has been entered.

Response to Amendment

Claim Rejections - 35 USC § 112

3. Claims 1-70 and 119-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's specification does not disclose adequate structure for performing the recited function. For example, in claims 1 and 119-121 the applicant claims a means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret. In claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62-63, 67 and 69, applicant claims a means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret), means for specifying security measures, means for associating said security measures with a trade secret, means for specifying, means for determining which security measures are needed, means for specifying security threats, means for analyzing the ratio, means for specifying values for the six factors of a trade secret, means for determining employee exposure to a trade secret, means for characterizing employee exposure, means for characterizing security risk. In claim 19, applicant claims a means for calculating from the specified security measures a security measures factor for a trade secret. What is the means for providing the predetermined criteria for evaluating? What is the means for doing the calculation?

Therefore, applicant is respectfully requested to specifically point out the means in the claim limitation and the functionality of these means in performing the steps or functions. (See MPEP Section 2181)

How is the calculation performed? The applicant has provided no formulas with which the applicant performs the calculation. The applicant has not defined how the security measure factor is determined. The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. How

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are the values weighted? How is the net present value of a trade secret calculated? How is the economic benefit factor calculated? What and how are the characterizations as to whether the trade secret constitutes negative know-how made? In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations. How are the security threats factors calculated?

How is the indexing performed, how are the trade secret drafts converted into trade secret application?

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62-63, 67 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is a combinational trade secret? What is negative know-how?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 119-121 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

Referring to Claim 1, 3-35, 37-39 43-44, 47-57, 60-63, 67-70, and 119-121:

Donner discloses a system for providing documentation, analysis, auditing, and accounting of IP (which includes trade secrets), said system comprising:

a data processing means for calculating (Fig. 1 (6), Fig. 8 (250); col. 11, lines 1-10);

a user interface means for providing predetermine criteria for a user to evaluate a potential trade secret and to receive a numerical score (Figure 1 (2); Fig. 7, Fig. 8 (264));

a mass data storage means (Fig. 1 (4)(5), Fig. 2);

a means for indexing (Fig. 3 (indicator collection organizing device));

a means for storing or archiving or indexing (Fig. 1 (4) (5), Fig. 2);

a means for associating (Fig. 1 (10), Fig. 3 comparison device);

a means for analyzing, comparing and weighing (col. 5, lines 5-17; Figure 1 (8) Figure 2 (20));

a means for ranking (col. 9, lines 61-64)

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The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art system is fully capable of performing that function (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)).

5. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 119-121 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

Elder discloses a system comprising:

data processing means (Fig. 3 (136);

user interface for providing predetermined criteria and receiving data (Fig. 1 (20));

mass data storage means (Fig. 1 (15, 10, 30, 35, 40, 50) Fig. 3 (135)

printer means (Fig. 3 (137), Fig. 12 (118))

calculating means (Fig. 1 (400), Fig. 12 (772))

comparison or analysis means (Fig. 12 (773)

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art is fully capable of performing the function. (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 42, 45-46, 58-59 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner and Elder as applied to claim 1 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber).

Neither Donner or Eder disclose an application fingerprint of the data. However, Haber discloses creating an application fingerprint of the data (col. 3, lines 50-55).

It would have been obvious to one of ordinary skill in the art to combine the fingerprint as taught by Haber with the scoring and ranking disclosed in Donner and Eder so that once the scored and ranked information is stored, there is a way to verify the date so that, should the time become a matter for later proof, the established procedure serve as effective evidence in substantiating the fact.

7. Claims 2 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner as applied to claim 1 above, and further in view of Eder.

Donner does not disclose a printer. However, Eder discloses a printer (Figure 7 (137)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the auditing system of Donner the printer of Eder so that the reports generated could be produced for in hardcopy for review and storage.

Response to Arguments

8. Applicant's arguments filed January 18, 2005 have been fully considered but they are not persuasive.

The Examiner has renewed the rejection under 35 USC 112, first paragraph. The specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

The Examiner has renewed the rejection under 35 USC 112, second paragraph.

As for the rejection as to the claims being rejected by Donner and Eder, the rejections have been maintained. The applicant has claimed a system. Therefore, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior

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art structure, the examiner should establish a prima facie case, and then the burden shifts to the applicant to prove otherwise. Applicant has failed to meet this burden. It is the Examiner's position that both Donner and Eder disclose all the claimed structural limitations and that the disclosed structure is capable of performing the recited function.

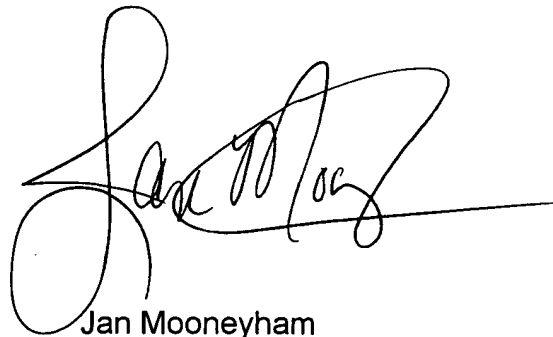
Since applicant is claiming a system in this application, applicant must identify in the specification the corresponding structure or the equivalents for the "means for." It is the Examiner's position that the applicant has failed to make clear the corresponding structure or acts disclosed in the specification for the means plus function language.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
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